

## **REMARKS**

This is in response to the Office Action mailed on July 19, 2007. Claims 1-57 and 59-62 are pending and are rejected under 35 USC § 103(a). Applicant submits herewith a Supplemental § 131 Declaration. In light of the Supplemental Declaration and the arguments below, reconsideration and allowance of the present application are respectfully requested.

### **Examiner's Statement that Declaration Under 37 C.F.R. § 1.131 is Ineffective**

The Examiner considered the Declaration Under 37 C.F.R. § 1.131 but has stated that it is ineffective to overcome the following references: Cockrill et al. (U.S. Patent No. 6,473,740); Elston (U.S. Patent No. 6,055,505); Brisebois (U.S. Patent No. 6,330,550); Shur (U.S. Patent No. 6,330,672); Vance et al. (U.S. Patent No. 6,442,526); and Martin (U.S. Patent No. 6,390,362).

The Applicant submits with this response a Supplemental Declaration Under 37 C.F.R. § 1.131 which swears back of the following references in accordance with 37 C.F.R. § 1.131 and MPEP § 715, as described further herein:

U.S. Patent No. 6,473,740 to Cockrill et al.;  
U.S. Patent No. 6,055,505 to Elston;  
U.S. Patent No. 6,330,550 to Brisebois et al.;  
U.S. Patent No. 6,330,672 to Shur;  
U.S. Patent No. 6,442,526 to Vance et al.; and  
U.S. Patent No. 6,390,362 to Martin.

This declaration is seasonably presented in accordance with MPEP § 715.09(A) and effectively antedates these references in accordance with MPEP § 715 by demonstrating conception of the present invention at least as early as October 4, 1997, prior to the effective date of these references, coupled with due diligence to the filing date of the provisional application hereof, U.S. Application No. 60/166,837, filed November 22, 1999.

The declaration more clearly delineates which facts in the applicant's Notebook Entries support the applicant's claim of conception of the invention by at least the sworn date of October 4, 1997. The declaration further demonstrates in accordance with MPEP 2138.04 that each

feature and limitation of the claims was known to the applicant and documented in the Notebook Entries provided to the Examiner in the response of May 17, 2007 by at least the sworn date.

The Applicant further asserts that the inventor's updated declaration combined with the Notebook Entries provided to the Examiner in the response of May 17, 2007 are adequate to demonstrate reasonable diligence throughout the entire critical period from at least October 4, 1997, to the date of reduction to practice. As demonstrated by the inventor's Supplemental Declaration and the Notebook Entries, the inventor was engaged in reasonably continuous activity towards a reduction to practice.

The Applicant would like to direct the Examiner's attention again to the reproduction of the inventor's notebook entries, with evidence of this ongoing activity towards a reduction to practice being recorded on at least October 4, 1997, November 20, 1997, November 28, 1997, December 5, 1997, January 17, 1998, March 6, 1998, March 20, 1998, April 14, 1998, May 21, 1998, May 24, 1998, June 25, 1998, July 19, 1998, September 3, 1998, September 12, 1998, November 26, 1998, December 9, 1998, January 14, 1999, February 6, 1999, March 22, 1999, May 26, 1999, July 7, 1999, August 1, 1999, August 3, 1999, October 2, 1999, and October 30, 1999. Applicant notes that evidence of diligent activity occurring every single day need not be present if a satisfactory explanation is provided. *Monsanto v. Mycogen*, 261 F.3d 1356, 1369 (Fed. Cir. 2001). Moreover, a declaration must be considered "in its entirety, including the affidavits or declarations...", MPEP § 715.07(I), and the Patent and Trademark Office must accept the factual allegations of a Rule 131 affidavit or declaration as true. *Herman v. William Brooks Shoe Co.*, 39 U.S.P.Q.2d 1773, 1777 (S.D.N.Y. 1996) ("the PTO is required to accept Rule 131 Affidavits at face value, and without investigation."). The Applicant submits that the inventor's explanation of his activities in the updated declaration is sufficient to show that the inventor was working towards a reduction to practice of the invention in a reasonably diligent manner.

Accordingly, the 35 U.S.C. § 103 rejections are now moot, as described in more detail below.

**Claim Rejections Under 35 U.S.C. § 103**

Claims 1-10, 12-14, 16, 18, 20-27, 29-31, 33, 56 and 59-61 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao et al. (U.S. Patent No. 6,529,725) in view of Cockrill et al. (U.S. Patent No. 6,473,740). The 37 C.F.R. § 1.131 declaration effectively antedates the Cockrill reference, which has a filing date of November 29, 1998. Accordingly, this rejection is now moot.

Claims 11, 17, 28, 36, 37, 39 and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao et al. in view of Elston (U.S. Patent No. 6,055,505). The 37 C.F.R. § 1.131 declaration effectively antedates the Elston reference. Elston has a filing date of December 30, 1997, and because it was not published until it issued on April 25, 2000, Elston was a 35 U.S.C. § 102(a) or (e) reference, not a statutory bar under 35 U.S.C. § 102(b). Accordingly, this rejection is now moot.

Claims 15 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao in view of Blonder et al. (U.S. Patent No. 5,760,771). These dependent claims depend from allowable claims 1 and 18, respectively. Accordingly, claims 15 and 32 are also allowable

Claims 19 and 57 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao et al. in view of Brisebois et al. (U.S. Patent No. 6,330,550). The 37 C.F.R. § 1.131 declaration effectively antedates the Brisebois reference, which has a filing date of December 30, 1998. Accordingly, this rejection is now moot.

Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao et al. in view of Shur (U.S. Patent No. 6,330,672). The 37 C.F.R. § 1.131 declaration effectively antedates the Shur reference. Shur has an effective date of December 3, 1997<sup>1</sup>, and because it

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<sup>1</sup> The Shur reference was filed on June 30, 1998 and claims priority to a provisional patent application filed on December 3, 1997. Applicants have not studied the provisional application, and therefore this statement should not be construed as an admission by Applicant that the teachings relied upon in the Shur reference are adequately described and enabled in the provisional application. If they are not, Applicant submits that the effective date of the Shur reference is its filing date, June 30, 1998. Regardless of this analysis, Shur is antedated by the 37 C.F.R. § 1.131 declaration.

was not published until it issued on December 11, 2001, Shur was a 35 U.S.C. § 102(a) or (e) reference, not a statutory bar under 35 U.S.C. § 102(b). Accordingly, this rejection is now moot.

Claims 35, 42-46 and 51-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao et al. in view of Vance et al. (U.S. Patent No. 6,442,526). The 37 C.F.R. § 1.131 declaration effectively antedates the Vance reference. Vance has a filing date of March 22, 1999, and is a continuation-in-part application of U.S. Application No. 08/951,630, filed on October 19, 1997, which ultimately issued into U.S. Patent No. 7,050,986. However, because the 08/951,630 parent application fails to disclose “preapproving employee corporate credit card usage for selected purchases”, which is the teaching for which the Vance reference (U.S. Patent No. 6,442,526) is relied upon (see OA dated 11/17/2006, p. 8), the effective date of the Vance reference (U.S. Patent No. 6,442,526) for purposes of this § 103 rejection is its filing date, March 22, 1999. This effective date is antedated by the 37 C.F.R. § 1.131 declaration.

Claim 38 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao et al. in view of Elston as applied to claim 36, and further in view of Official Notice. The 37 C.F.R. § 1.131 declaration effectively antedates the Elston reference as described above. Accordingly, this rejection is now moot.

Claim 41 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao et al. in view of Elston and Vance et al. The 37 C.F.R. § 1.131 declaration effectively antedates the Elston and Vance references as described above. Accordingly, this rejection is now moot.

Claim 47 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao et al. in view of Vance et al. as applied to claim 42, and further in view of Official Notice. The 37 C.F.R. § 1.131 declaration effectively antedates the Vance reference as described above. Accordingly, this rejection is now moot.

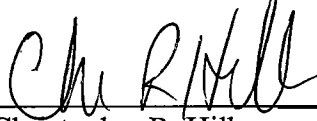
Claim 48 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao et al. in view of Vance et al. as applied to claim 42, and further in view of Martin (U.S. Patent No. 6,390,362). The 37 C.F.R. § 1.131 declaration effectively antedates the Vance reference as described above. Further, the 37 C.F.R. § 1.131 declaration effectively antedates the Martin

reference, which has a filing date of September 14, 1999 and is a continuation-in-part of U.S. Application No. 09/345,202, filed on June 30, 1999. Accordingly, this rejection is now moot.

### **CONCLUSION**

Applicants submit that all pending claims are allowable over the art of record and respectfully request that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach Chris Hilberg at (612) 607-7237. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 18822-11).

Respectfully submitted,



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